REMARKS

This paper is responsive to an Office Action mailed January 10, 2008. Prior to this response, claims 1-40 were pending. After amending claims 1, 7-8, 12, 18-19, 22, and 32, canceling claims 5-6, 9-10, 16-17, 20-21, 26-27, 29-30, 36-37, and 39-40, and adding claims 41-44, claims 1-4, 7-8, 11-15, 18-19, 22-25, 28, 31-35, 38, and 41-44 remain pending.

In Section 2 of the Office Action claim 12 is objected to because of an informality. In response, the Applicant copy of claim 12 does not show a period after the word "encapsulating" in line 4. However, the copy of the claims in PAIR does appear to show a mark. Therefore, the Applicant is inserting a period into claim 12, and amending the claim to remove the period.

In Section 3 of the Office Action claims 22 and 32, and claims dependent from these claims, have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Office Action states that the recited "receiver" and "de-jitter module" are software constructs. This rejection is traversed as follows.

In response, the Applicant notes that the subject matter of claims 22 and 32 is not software constructs, but rather, parts of a system, which might also be referred to as a machine. A "machine" is one of the four enumerated categories of patentable subject matter described in 35 U.S.C. 101. A receiver, for example, includes hardware components that amplify and filter the incoming signal, convert the incoming signal to a

baseband signal, and demodulate the incoming signal. These are functions that cannot be performed using software. Likewise, a de-jitter module must include buffer and register components to load, compare, and manipulate a digital signal.

Further, "(t)he question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to – process, machine, manufacture, or composition of matter – [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristic of the subject matter, in particular, its practical utility" *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602.

Since the transmission and reception of MPEG2TS streams via an IP packet is process that is probably performed billions of times each day, the final result achieved by the claimed system is "useful, tangible, and concrete", which also meets the requirements for 35 U.S.C. 101.

As noted in the MPEP 2107.02 IV - To properly reject a claimed invention under 35 U.S.C. 101, the Office Action must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide sufficient evidentiary basis for factual assumptions relied upon in making the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). "Accordingly, the PTO must do more than merely question operability – it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." If the Office Action cannot develop a proper *prima facie* case and provide evidentiary support under 35 U.S.C. 101, a

rejection on this ground should not be imposed. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Office Action merely states that the claimed invention lacks a practical application, without making a *prima facie* case for the statement, and without an evidentiary support.

The claimed invention is a machine, one of the four statutory categories of Section 101, tied to the physical world by being embodied in sub-components such as a receiver, transmitter, de-jitter module, and encapsulation module, and has practical utility. For these reasons, and because a *prima facie* case for rejection has not been supported, the Applicant respectfully requests that the rejection be removed.

In Section 5 of the Office Action claims 1, 3-12, 14-22, 24-32, and 34-40 have been rejected under 35 U.S.C 102(e) as anticipated by Ueda et al. ("Ueda"; US 2004/0190459). The Office Action states that Ueda discloses all the limitations of claims 1, 12, 22, and 32 in paragraphs [0009-0010, 0074-0075, and 0122-0123].

To further clarify the Applicant's invention from Ueda, independent claims 1, 12, 22, and 32 have been amended to include the subject matter of claims 6, 17, 27, and 37, respectively. Claims 6, 17, 27, and 37 are now canceled. The Office Action states that Ueda discloses the limitation of an index field in an RTP packet header, citing paragraphs [0009-0010], [0074-0075], and Fig. 25. The Office Action states that Ueda discloses the limitation of using the index to point to a PCR MPEG2TS randomly positioned in the RTP packet payload, using the same cites. This rejection is traversed as follows.

"Fig. 25 is a diagram showing the configuration of RTP process unit 500 employed in the conventional communications apparatus" [0008]. Reference designator 504 is described as PCR registers. Packet synthesis unit 506 generates RTP a timestamp from the value of the PCR filed stored in the PCR register 504 [0010].

Paragraphs [0009-0010] in Ueda disclose a conventional process where MPEP2 TS packets are carried in an RTP packet. The process generates a timestamp from the PCR field, which is included in the RTP header. The Applicant's Background Section discloses similar information in the description of Fig. 13:

> Fig. 13 is a diagram illustrating real-time protocol (RTP) as defined by RFC 2250 (prior art). More specifically, a RTP/user datagram protocol (UDP) packet is shown as carried in an IP packet. Conventionally, the RTP packet includes an RTP packet header and a plurality of MPEG2TSs in the RTP payload. The RTP header includes a 32-bit synchronization timestamp, which is referred to herein as a RTP timestamp. Note, the RTP timestamp is not intended for use in recovering the video system target decoder clock. Also note that the RTP timestamp is not associated with any particular MPEG2TS in the RTP payload. Further, the 32-bit RTP timestamp only has a resolution of 90 kilohertz (kHz), insufficient for a 500 ns systems requirement.

Ueda's paragraphs [0074 and 0075] disclose a transmission process that generates an RTP packet by adding an RTP header to a TS (Fig. 1). The RTP header includes an RTP timestamp and RTP sequence number. A reception process depacketizes the payload from the RTP packet. A timer 130 is used to measure the arrival times and arrival time jitter is computed.

The Applicant notes that the above-cited sections from Ueda do not describe a process that accesses an index field in a RTP packet header, or that uses the index to locate a PCR MPEG2TS randomly positioned in the RTP payload (claims 1 and 22). Neither does Ueda describe a process that encapsulates an index field to a RTP packet header for use in locating a PCR MPEG2TS that is randomly positioned in the RTP payload (claims 12 and 32).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Ueda does disclose every limitation of claims 1, 12, 22, and 32, as amended. Since Ueda does not disclose every limitation of the claimed invention, he cannot anticipate. Claims 3-4, 7-8, and 11, dependent from claim 1, claims 14-15 and 18-19, dependent from claim 12, claims 24-25, 28, and 31, dependent from claim 22, and claims 34-35 and 38, dependent from claim 32 enjoy the same distinctions from the cited prior art.

In Section 28 of the Office Action, claims 2, 13, 23, and 33 have been rejected under 35 U.S.C. 103(a) with respect to Ueda in view of Ando et al. ("Ando"; US 7,274,863). The Office Action acknowledges that Ueda fails to disclose a timestamp resolution of 500 ns, but that Ando discloses this feature, and that it would have been obvious to modify Ueda to include the teachings of Ando to synchronize the timestamp with the value stored in the TS packet. This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that that Ueda discloses all the limitations of the base claims 1, 12, 22, and 32. However, even if Ando's timestamp resolution is added to Ueda, the combination of references fails to disclose the limitations of accessing an index field in a RTP packet header, or using the index to locate a PCR MPEG2TS that is randomly positioned in the RTP payload, as recited in Applicant's claims 1 and 22. Neither does the combination of references describe a process that encapsulates an index field to a RTP packet header for use in locating a PCR MPEG2TS that is randomly positioned in the RTP payload, as recited in claims 12 and 32.

Further, the motivation of synchronization does not suggest modifications to Ueda that would make the Applicant's claim limitations obvious, based on either the Ando reference, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Ueda that would make all the limitations obvious, the Applicant requests that the rejection of claims 2, 3, 23, and 33 be withdrawn.

New independent claims 41 and 43 have been added. Claim 41 includes the subject matter of claims 1 and 9. Claim 43 includes the subject matter of claims 12 and 20. The Office Action states that Ueda discloses the limitation of a local timestamp field in an MPEG2TS delay compensation structure, citing 504 of Fig. 25, [0009-0010], [0074-0075]. The Applicant has provided a detailed analysis of the above citations in response to Section 10 of the Office Action. The above-cited portions of Ueda are absolutely silent on the subject of a local timestamp field and an MPEG2TS delay compensation data structure. Since Ueda does not

describe these limitations, he cannot anticipate claims 41 and 43. Claim 42, dependent from claim 41, and claim 44, dependent from claim 43, enjoy the same benefits over the Ueda reference.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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